

REMARKS / DISCUSSION OF ISSUES

Claims 1-12 are pending in the application. Claims 1-3 and 6-8 are allowed. Claims 4, 5 and 10-12 are rejected. Claims 9 and 10 are objected to.

Claims 9 and 10 are objected to because of the use of more than one capital letter in the body of the claims. Claims 9 and 10 are corrected by the present amendment.

Claims 4, 5 and 10-12 are rejected under 35 USC 112, second paragraph, in that the term 'trace amount' in claim 10 is relative and undefined and therefore indefinite.

Claim 10 is currently amended to change the term 'a trace amount' to 'an effective amount'.

The phrase "an effective amount," commonly used in the chemical and biological arts, may or may not be indefinite. The test to determine whether such terminology is definite is whether one skilled in the art can determine specific values of what is an "effective amount" based on the disclosure. This is often gleaned from the specification. Thus, the phrase "an effective amount . . . for growth stimulation" was held to be definite where the amount was not critical and those skilled in the art could determine from the specification what an effective amount meant. See In re Halleck, 422 F.2d 911 (CCPA 1970). However, the phrase "an effective amount" was held to be indefinite when the claim failed to state the function to be achieved by such "effective amount" and more than one effect could be implied from the specification or the relevant art.

Accordingly, claim 10 is also currently amended to state the function to be achieved by such effective amount, namely, to result in an improved CRI when compared to conventional lamps with sleeves that are devoid of neodymium. Support for this terminology may be found, for example, at page 3, lines 4-7, of Applicant's specification.

Thus, it is urged that by the present amendment, claim 10 and its dependent claims 4, 5, 11 and 12 are in conformity with 35 USC 112, second paragraph, and that the rejection be withdrawn.

Claims 4, 5 and 10-12 are rejected under 35 USC 112, first paragraph, in that the phrase 'more than a trace amount of neodymium' in claim 10 is unsupported by the specification and new matter because the original disclosure does not mention any amount of neodymium.

Claim 10 is currently amended to change the term 'a trace amount' to 'an effective amount'.

The term 'an effective amount' is inherently disclosed in Applicant's original disclosure, where it is clearly taught that neodymium is present in any of various ways such as in the form of a protective sleeve which is composed of or has a coating of neodymium, or is merely doped with neodymium, to result in an improved CRI when compared to conventional lamps with sleeves that are devoid of neodymium. See page 3, lines 4-7, of Applicant's specification. Clearly, if an effective amount were not present, then the intended effect of an improved CRI would not be obtained.

Thus, it is urged that by the present amendment, claim 10 and its dependent claims 4, 5, 11 and 12 are in conformity with 35 USC 112, first paragraph, and that the rejection be withdrawn.

Claims 4, 10 and 12 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,157,131 to Nelson in view of U.S. Patent No. 6,136,736 to Rajaram.

Nelson discloses a metal halide lamp, but as acknowledged by the Examiner, fails to 'exemplify' a protective sleeve comprising neodymium.

Rajaram teaches a glass composition for an arc tube for a metal halide or mercury lamp. The glass is essentially at least 90% silica, and includes from 10 to 1000 ppm of one or more element from a group of 30 trivalent elements, such that the viscosity of the glass is greater than $10^{14.5}$ at 1100 C. There is no mention of a protective sleeve surrounding the arc tube, nor of the possible effect of neodymium in such a protective sleeve on the color rendering index (CRI) of the lamp.

Moreover, there is no guidance in the disclosure of Rajaram which would even lead to the selection of neodymium from the group of 30 elements for inclusion in the glass composition of the arc tube.

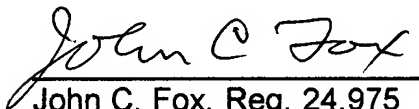
Rajaram is utterly devoid of any teaching or suggestion which would lead the skilled artisan to employ neodymium as or in a protective sleeve surrounding a light source such as an arc tube to obtain an improvement in CRI.

Accordingly, the combination of Nelson and Rajaram fails to render unpatentable claims 4, 5 and 10-12, and the rejection is in error and should be withdrawn.

The allowance of claims 1-3 and 6-8 is noted with appreciation. However, in view of the above arguments and amendments, it is felt that all of the pending claims are now in allowable form.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the objections and rejections of record, allow all of the pending claims, and find the application to be in condition for allowance.

Respectfully submitted,


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